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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

05725.1226-00000

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Signature _____

Typed or printed name _____

Application Number

10/619,612

Filed

July 16, 2003

First Named Inventor

Vincent DE LAFORCADE

Art Unit

3732

Examiner

Robyn Doan

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☒

attorney or agent of record.

Registration number 38,742☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Anthony M. Gutowski (Reg. No. 50,585)
Signature

for **Anthony M. Gutowski**
Typed or printed name

571-203-2774
Telephone number

June 19, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT
Customer No. 22,852
Attorney Docket No. 05725.1226-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Vincent DE LAFORCADE et al.)	Group Art Unit: 3732
)	
Application No.: 10/619,612)	Examiner: Robyn A. DOAN
)	
Filed: July 16, 2003)	
)	
For: APPLICATOR NOZZLE AND)	Confirmation No.: 6532
APPLICATOR ASSEMBLY)	
INCORPORATING SUCH A NOZZLE)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In conjunction with a Notice of Appeal under 37 C.F.R. § 41.31 and completed Form PTO/SB/33 filed concurrently herewith, Applicants respectfully request a pre-appeal brief review of this application.

Claims 1-110 are pending in this application, with claims 1, 24, 39, 62, 84, 91, and 105 being independent claims. Of those pending claims, claims 24-38 have been withdrawn from consideration as being allegedly drawn to a non-elected subject matter.

In the Office Action mailed March 19, 2007 ("Office Action"), claims 1, 2, 4-6, 9-23, 39, 40, 42-44, 47-63, 65, and 68-110 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,101,086 to Di Vito ("Di Vito") in view of U.S. Patent No. 1,686,936 to Simpson ("Simpson"). In addition, claims 3, 7, 8, 41, 45, 46, 64, 66, and 67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Di Vito in view of Simpson, and further in view of

U.S. Patent No. 1,180,199 to Smith ("Smith"). For at least the following reasons, these rejections should be withdrawn.

35 U.S.C. § 103(a) Rejection Based on Di Vito and Simpson

Independent claim 1 is directed to an applicator nozzle, comprising, among other things, "an arrangement of at least two teeth ..., at least one of the teeth of the arrangement defining a channel being configured to be placed in flow communication with product contained in [a] receptacle, the channel opening on an exterior of the at least one tooth via at least one outlet aperture facing substantially in a direction of at least one adjacent tooth." Claims 39 and 62 include similar recitations.

Independent claim 84 is directed to an applicator nozzle comprising, among other things, "a plurality of teeth, at least one of the teeth defining a channel," "at least one outlet aperture in flow communication with the channel, the outlet aperture opening to an exterior of the tooth on an external lateral surface of the at least one tooth," and "at least one groove ... extending from the outlet aperture ..., wherein the at least one groove faces an adjacent tooth."

Independent claim 91 is directed to an applicator nozzle comprising, among other things, "at least two teeth arranged in at least one row, at least one tooth of the row having at least one outlet aperture configured to permit product to flow therethrough for application to a surface, ... wherein the outlet aperture faces in a direction of an adjacent tooth."

Independent claim 101 is directed to an applicator nozzle comprising, among other things, "a row of teeth ... comprising: at least one tooth defining a channel configured to allow product to flow therethrough, the channel opening on an exterior of the tooth via at least one outlet aperture facing in a direction of an adjacent tooth."

As detailed below, Di Vito and Simpson, taken either alone or in combination, do not teach or otherwise suggest the subject matter of each of independent claims 1, 39, 62, 84, 91, and 101.

Di Vito discloses a combined dispenser and comb device comprising a flask 10 and a hollow comb 20 engageable with a neck 16 of flask 10. Comb 20 includes solid or imperforated teeth 22 interspersed with hollow open-ended teeth 24, as shown in Figs. 1 and 2.

Simpson discloses a fountain comb having a container 10 and teeth 18 extending from container 10. Teeth 18 include tubular openings 17 extending from container 10 and, at their lower ends, form a spoon-shaped or U-shaped cross-section, defining channels 19. As best shown in Figs. 1 and 3, channels 19 are open at their front side. See also page 2, lines 19-21, of Simpson.

As is abundantly clear, neither Di Vito nor Simpson teaches or suggests, among other things, “at least one outlet aperture facing substantially in a direction of at least one adjacent tooth,” as recited in independent claim 1 (claims 39 and 62 include similar recitations), “at least one groove [facing] an adjacent tooth,” as recited in independent claim 84, “the outlet aperture [facing] in a direction of an adjacent tooth,” as recited in independent claim 91, and “at least one outlet aperture facing in a direction of an adjacent tooth,” as recited in independent claim 101.

While acknowledging these deficiencies of Di Vito and Simpson, the Office Action merely cites In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950), and alleges that “it would have been obvious ... to position the outlet aperture of Simpson facing substantially in a direction of at least one adjacent tooth, since it has been held that rearranging location of parts of an invention involves only routine skill in the art.” Applicants respectfully submit that the Office Action’s mere reliance on the Japikse case to assert, without any factual basis, obviousness of a missing element is clearly erroneous.

For example, the Office Action merely relies on the Japikse case for a general proposition that “rearranging location of parts of an invention involves only routine skill in the art.” Applicants’ review of the case, however, reveals no such generalized proposition or rule of law. On the contrary, the Board of Patent Appeals and Interferences (“Board”) has made it clear that Japikse should be limited to the facts of that particular case (i.e., missing subject matter

relating to the position of a starting switch is immaterial and the overall operation of the device at issue in the Japikse case would not be affected by the position change). Ex parte Robles, 1997 WL 1883840 (Bd. Pat. App. & Interf.). Moreover, the Board has expressly rejected application of Japikse as a per se rule of obviousness and held that reliance on Japikse to establish obviousness under 35 U.S.C. § 103(a), without supplying a factual basis, is improper. See Ex parte Makutonin, 2003 WL 23014547 (Bd. Pat. App. & Interf.).

In this case, the Office Action did not provide any factual basis or otherwise sufficient reasoning to support its allegation that rearranging the position of channels 19 of Simpson involves only routine skill in the art. In fact, the Office Action did not even carry out the prerequisite analysis (i.e., comparing the facts of the present case to those of Japikse) to determine whether any alleged holding in Japikse is even applicable in this case. Absent any such factual basis, as discussed above, the Office Action's mere reliance on Japikse to establish obviousness under 35 U.S.C. § 103(a) is improper and clearly erroneous.

In addition, contrary to the Office Action's allegation, rearranging the position of channels would not have been obvious to one of ordinary skilled in the art because, among other reasons, rearranging the position in the manner alleged by the Office Action would materially alter the overall operation of the Simpson device. For example, Simpson expressly teaches that channels 19 are open at their front sides. See, e.g., Page 2, lines 29-30. These channels 19, forming spoon-shaped cross-sections, are used to remove dandruff (or other substances) from the roots of the hair and the scalp while the device is used substantially the same as an ordinary comb. See, e.g., page 2, lines 20-29 and 71-96. That is, while the device is used in an ordinary combing action (e.g., brushing in the forward direction perpendicular to a side of the device), channels 19 facing the same forward direction raise and carry dandruff from the scalp. If, however, channels 19 of Simpson were modified to face a direction of adjacent teeth, as alleged by the Office Action, channels 19 would more than likely not be able to remove dandruff from the scalp in an ordinary brushing action, thereby necessarily destroying the express teachings

of Simpson. Therefore, rearranging the position of channels 19 of Simpson would not have been obvious to one of ordinary skill in the art.

For at least the reasons set forth above, the Office Action's rejection under 35 U.S.C. § 103(a) based on the alleged combination of Di Vito and Simpson is in error, and each of independent claims 1, 24, 39, 62, 84, 91, and 105 patentably distinguishes from the cited references. Therefore, this rejection under 35 U.S.C. § 103(a) should be withdrawn.

35 U.S.C. § 103(a) Rejection Based on Di Vito, Simpson, and Smith

Dependent claims 3, 7, and 8 depend from independent claim 1, dependent claims 41, 45, and 46 depend from independent claim 39, and dependent claims 64, 66, and 67 depend from independent claim 62. As discussed above, independent claims 1, 39, and 62 patentably distinguish from the alleged combination of Di Vito and Simpson. Also, Smith does not supply all of the deficiencies of Di Vito and Simpson. Therefore, these dependent claims should also patentably distinguish from the cited references at least by virtue of their respective dependencies from independent claims 1, 39, or 62.

Conclusion

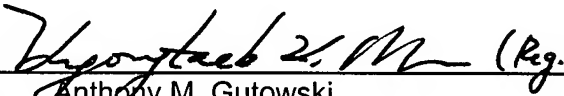
Applicants respectfully request reconsideration of this application, withdrawal of the outstanding 35 U.S.C. § 103(a) rejections, and allowance of all pending claims.

Please grant any extensions of time required to enter this request and charge any additional required fees to our Deposit Account No. 6-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 19, 2007

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